

REMARKS

The present response is intended to be fully responsive to the rejection raised in the Office action, and is believed to place the application in condition for allowance. Further, the Applicants do not acquiesce to any portion of the Office Action not particularly addressed. Favorable reconsideration and allowance of the application is respectfully requested.

In the Office action, the Office noted that claims 1-21 are pending and rejected. Applicants cancel claims 15-21. In view of the following discussion, the Applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. § 103. Thus, Applicants believe that all of these claims are now in condition for allowance.

REJECTION

The Office rejected claims 1-5, 8-12 and 15-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,442,527 issued to Worthington (hereon after “Worthington”) in view of U.S. Patent Publication No. 2008/0154116 published to Lofton (hereon after “Lofton”). The Office also rejected claims 6-7, 13-14 and 20-21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,442,527 issued to Worthington (hereon after “Worthington”) in view of U.S. Patent No. 6,442,527 issued to Lofton (hereon after “Lofton”), in further view of U.S. Patent Publication No. 2004/0078752 published to Johnson Jr. (hereon after “Johnson”). The Applicants respectfully traverse the rejections.

In support of the rejection to claim 1, the Office indicated that

“All the claimed elements were known in [Worthington] and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, as Lofton does not teach away from or contradict Worthington, but rather, teaches an additional feature that was not addressed.” *Office Action*, at page 5 and 6.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claimed limitations. The teaching or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F. 2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Furthermore, as the Office is also aware, the courts have repeatedly stated that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983).

Claim 1 recites a combination of elements directed to a "hand-held computer device." The combination of elements includes "create a time management entry in a time management application; attach a file stored in the memory to the time management entry; and display the file on a display of the hand-held computer device."

In the Office Action, the Office indicated that "a laptop computer is a hand-held device." *Office Action*, at page 5. Accordingly, the Office insinuated that *Worthington* discloses all the elements of claim 1. Applicants respectfully disagree. The Applicants would request that the Office distinguish between a portable device and a hand-held device. Applicants submit that it is well known in the art that there is distinction between a hand-held device and a portable device in that a hand-held device is a device that relatively fits in ones pocket. Accordingly, a laptop is not a hand-held device, but rather a portable device.

The Office indicated that *Worthington* discloses "a hand-held computer device" in col. 3, lines 52-55. *Worthington* discloses "the system 1 of the invention is implemented through a data processing unit such as a mainframe computer, a home computer, or a laptop." *Worthington*, at col. 3 lines 52-55. Therefore, unlike claim 1, *Worthington* discloses a laptop and not a hand-held device.

Lofton, on the other hand, specifically discloses "personal computer", for example, pages 1-3 and 9-10. *Lofton* is devoid from disclosing a "hand-held device", as recited in claim 1.

Claim 8 recite features similar to those recited in claim 1. Moreover, Applicants note that the Office cited *Worthington* and *Lofton* for the proposition that it teaches all of the elements of independent claims 1 and 8, from which the

dependent claims 6-7 and 13-14 ultimately depend. The Applicants also note that the Office only cited *Johnson* with respect to the subject matter claimed in the dependent claims 6-7 and 13-14.

Accordingly, it is Applicant's opinion that *Worthington*, *Lofton* and *Johnson*, alone and in combination, do not suggest or show a motivation for modifying the reference or to combine the reference teachings. In addition, it is Applicant's opinion that there is no evidence in any of the prior art that shows a "reasonable expectation of success" in combining the references. Thus, it is Applicant's belief that a *prima facie* case of obviousness has not been provided.

Given that each of the dependent claims 2-7 and 9-14 depend, directly or indirectly, from either independent claim 1 or 8, each necessarily includes all the elements of their respective independent claim. Since *Worthington* and *Lofton*, alone and in combination, do not teach all the elements of the independent claims 1 and 8 and since the Office only cited *Johnson* with respect to the subject matter claimed in the dependent claims 6-7 and 13-14, the Applicants, therefore, submit that *Worthington*, *Lofton* and *Johnson*, alone and in combination, do not teach all the elements or render claims 1 and 8 obvious. Thus, the Applicants further submit that *Worthington*, *Lofton* and *Johnson*, alone and in combination, do not render each of the dependent claims 2-7 and 9-14, depending from either claim 1 or 8, obvious under 35 U.S.C. §103(a).

The Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-14.

CONCLUSION

In view of the foregoing, the Applicants submit that none of the claims presently in the application are anticipates under 35 U.S.C. §102 or obvious under the provisions of 35 U.S.C. §103. In addition, the Applicants submit that all of the claims presently in the application comply with 35 U.S.C. §112. Consequently, the Applicants believe that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Office believes that any unresolved issues still exist or if, in the opinion of the Office, a telephone conference would expedite passing the present application to issue, the Office is invited to call the undersigned attorney directly at 972-917-4365 or the office of the undersigned attorney at 972-917-4363 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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